

## **REMARKS**

### 1. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 17, 31-33, 38-40 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant has cancelled claims 1-91 and added new claims 92 - 103. The new claims more particularly point out and distinctly claim Applicant's invention. The language of new claims is fully supported by the Applicant's specification and drawings.

### 2. Objection of Claims

The Examiner objected to claims 72, 26, 27, 41, and 89. The applicant has cancelled claims 1-91.

### 3. Rejection of Claims Under 35 U.S.C. § 102 and 35 U.S.C § 103

a. Kelly et al.

Claims 1-11, 14-22, 24-32, 41-45, 47-48, 50-66, 68-79, 81-91 were rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,015,344 to Kelly ('344). Claims 12-13, 23, 33-40, 46, 49, 67, 80 were rejected by the Examiner under 35 U.S.C 103(a) as being unpatentable over Kelly '344. The Examiner stated, inter alia, that Kelly '344 discloses a system and method of use of a prize redemption system which allows a player to play a game on a game apparatus in exchange for monetary input and wherein prize credits are credited to the players based on the game.

Although the Applicant has submitted new claims 92-103 herein to more particularly point out and distinctly claim the invention, the Applicant would like to clarify certain misconstructions by the Examiner in regard to the Kelly '344 disclosure. In several cases, the Examiner summarily rejects claims using improper hindsight reconstruction and misrepresenting the scope of disclosure taught by Kelly '344. For example, claim 10 was rejected by the Examiner stating "Kelly discloses a prize station comprising a vault housing, having a door secured by a latch in the form of vending machine, 1:55-57" (Examiner's Detailed Action, pg. 4). Nowhere in Kelly '344 is structure of a door secured by a latch taught, disclosed or suggested. If Examiner is aware of such a teaching, the Applicant requests a specific cite in order to respond properly.

Likewise claim 28 was rejected by Examiner stating “[Kelly] recite[s] issuing award credits upon winning events already discussed in claim 27, therefore refer to claim 27 for rejection; in addition Kelly discloses a gaming device configured to determine the number of previous award credits associated with players, 13:49-67, 15-14, and store award credits upon user’s termination of play of gaming device is well known.” On the contrary storing award credits in gaming devices is not well known. The Examiner’s broad sweeping assertions are not supported either by the Kelly ‘344 disclosure nor industry practice. Instead, the Examiner is relying upon the Applicant’s disclosure to serve as a basis for an obviousness rejection, which according to well established case law constitutes improper hindsight rejection (see: *C.R. Bard, Inc. v. M3 Systems, Inc*, 157 F.3d 1340 (Fed. Cir. 1998) and *In re Fitch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992)). *In re Fitch* sets forth the standard for modifications suggested by the Examiner. “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board. Here the Examiner relied upon hindsight to arrive at a determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *In re Fitch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

Examiner's summary rejections of such claims as 501, 52, 54-55, 62, 72, 85 more clearly demonstrates this improper hindsight rejection. In rejecting claim 85, for example, the Examiner merely asserts that "determining previously stored award credits upon player's reinitiation of game play of the gaming device is known feature in the gaming environment." (Examiner's Detailed Action, pg. 7). Although restoring game credits is known, restoring awards credit not usable for play (wager), is not known. There is no such teaching, disclosure, or suggestion either in the Kelly '344 patent nor in the prior art to support such Examiner's assertion. If Examiner is aware of such a teaching, the Applicant requests a specific cite in order to respond properly.

In other cases, Examiner either misunderstands or misrepresents the teaching of Kelly '344. For example, in rejecting claims 29, 42, 73, the Examiner's stated "in 12:22-39, Kelly discloses issuing universal tickets indicating the value of all the award credits accumulated by the players." (Examiner's Detailed Action, pg. 5). However, Kelly '344 only teaches that the specific prize ticket can be used as an alternative to dispensing multiple tickets for generating a "ticket receipt" (col. 12, ln. 27-32). That is instead of printing a bulk of universal tickets, a ticket receipt is printed containing an equivalent amount of prize credits. Kelly' 344 does not allows the ticket receipt to be re-inserted back into the gaming device for aggregation and accumulation, but can only be saved by the player by manual collection. Kelly '344 in fact teaches away from the present invention by indicating that "Player's can thus save one or more receipts indicating how many prize credits they have

accumulated” (col. 12, ln. 33-34). The notion that such printed tickets are intended to be re-inserted back into the gaming device is a violent misreading of the Kelly ‘344 system. The Examiner sites Col. 27, ln. 62-64 to support the idea that specific prize coupons or universal coupons may be re-inserted into the Kelly ‘344 gaming device. However, Kelly’ 344 only states that “the total number of tickets can be added to any preexisting ticket balance of the player, if appropriate.” This preexisting balance may simply be achieved from previous plays or from a player account; there is no teaching, disclosure, or suggestion of record to indicated that the “preexisting balance” was derived from an insertion of a specific prize coupons or universal coupons. If Examiner is aware of such a teaching, the Applicant requests a specific cite in order to respond properly.

**b. The Present Invention**

The present invention allows a player maintain a player’s game states through the use of a Prize Bearing Instrument (PBI). Typically, this involves printing and receiving of PBIs by the gaming device to restore the state of the game (primary game and/or secondary game as well as various states relevant to restoring the game, such as points, game pieces, or award levels), not mere restoration of game credits. More particularly, the gaming device of the present invention may be configured with a ticket printer and ticket reader for generating and reading printed tickets bearing indicia and information relevant to player’s game state. An illustrative embodiment disclosed by the Applicant (Fig. 2b) illustrates a sample secondary game which may be maintained and restored by the present invention. In that

example, the game restored constitutes game pieces comprising the letters B, O, N, U, S to form the word BONUS. The present invention further anticipates other embodiments of game formats and rules suitable for use with the primary and/or the secondary game.

In contrast, the Kelly '344 system issues either specific prize tickets which may only be exchanged for a specific prize (col. 10, ln. 50 - col. 11, ln. 38) or universal tickets which are "generic tickets" having a base redemption value (col. 9, ln. 44 -60). There is no teaching, disclosure or suggestion in Kelly '344 which would allow the player to reinsert the specific prize tickets or universal tickets to restore the player's game state on the gaming device. While the Kelly '344 system suggests that a player may accumulate prize credits from previous games (Col. 3, ln. 47-50), no structure, teaching, disclosure, or suggestion is made as to how this is achieved. If Examiner is aware of such a teaching, the Applicant requests a specific cite in order to respond properly. Furthermore, even if such a showing were present, the system of Kelly '344 would still not achieve the present invention which maintains and restore game states (game points, symbols, scores, game pieces, etc. related to game play, that are not simply game credit accumulation). Restoring of prize credits from previous games does not constitute maintaining either a primary or secondary game. Such an interpretation would be reading the Applicant's disclosure into the prior art, which as noted above constitutes impermissible hindsight reconstruction. Moreover, the mere fact that the player may be awarded a prize from play of the primary or secondary according to the present invention does not render the Kelly '344 disclosure capable of restoring game states. The example B-O-N-U-S game noted above, for example, illustrates that the present invention

could restore the state B-O-N in a game, whereas the Kelly '344 system would be limited to restoring a player's credit accumulation which serves a substantially different purpose and goal. Finally, the present invention benefits from the additional advantage that the player may restore his/her game state without requiring the player to establish a conventional player account, an often time consuming and intrusive process. Likewise, the structure required would be non-analogous and would require substantial modification and engineering effort. By using dynamically issued printed tickets which indicate the player's game state, the player can remain anonymous while allowing the player to later re-establish his/her game state. Even if the printed ticket of the present invention is recorded on a validation system as disclosed by the Applicant, the player need not provide personal identification information, and can thus remain anonymous.

Applicant has cancelled claims 1-91 without prejudice or disclaimer, and submitted new claims 92-103 to more particularly point out and distinctly claim the invention consistent with the above comments. Independent claim 92 now provides that the gaming device be capable of (i) generating a printed ticket having indicia identifying the player's game state, (ii) reading the printed ticket to determine the player's game state, and (iii) restoring the game to the state determined from the printed ticket. Applicant further recites the additional limitation that determined (or "restored") state does not comprise gaming credits suitable for establishing a wager to rule out gaming devices which merely restore gaming credits. Additionally, the preamble limits the scope of use of the present invention to gaming establishments. The Applicant also recites the limitation of a manager module which

restores a gaming device's game state. The manager module does not merely restore game credits, but restores the primary and/or secondary game. As described above, the state B-O-N in the example B-O-N-U-S game could not be restored without the manager module using information from the printed ticket having game state data. No such structure, teaching, suggestion or disclosure is provided either in Kelly '344 or the prior art. If Examiner is aware of such structure or teaching, the Applicant requests a specific cite in order to respond properly.

Independent method and apparatus claims 98 and 102 respectively includes analogous limitations and are submitted to be novel and non obvious for the same reasons described above for claim 92. As claims 93-97 depend from claim 92, claims 99-101 depend from claim 98, and claim 103 depends from claim 102, they necessary include all of the limitation of corresponding independent claims are submitted to be to be novel and non obvious for at least the same reasons and their corresponding independent claims. The limitations set forth in new claims 92-103 are fully supported by the Applicant's specification and drawings and do not constitute new matter. It is submitted that the rejections of record have been overcome.



4. Conclusion

Based on the above amendments, and remarks, the Applicant respectfully submits that all of the presently pending claims are in condition for allowance. Accordingly, the Applicant requests that the outstanding claim rejections be withdrawn, and that this case be passed to issue. The Applicant respectfully requests a telephone interview with the Examiner prior to a Final Office Action if the Examiner believes that claims are not considered allowable. A clean set of the claims have been submitted herewith as Appendix A.

Respectfully submitted,

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